



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Application of

Henry, Cheryl

Application Number

09/575,776

Filing Date

May 22, 2000

For

**DATA STORAGE DEVICE
READER AND METHOD OF
USING SAME**

Group Art Unit

2835

Examiner

Vortman, Anatoly

Attorney Docket

85611

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Appeal Brief Under 37 CFR §1.192

Mail Stop Appeal Brief—Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

This supports the appeal taken on February 7, 2003 from the Final Rejection dated November 8, 2002.

1. Real Parties in Interest

The real party in interest is the inventor, Cheryl Henry, as there has been no assignment by the inventor of her rights in the invention.

2. Related Appeals and Interferences

There are no related appeals or interferences.

3. Status of Claims

Claims 1-12 were filed and claims 13-22 were added by amendment earlier in the prosecution. Claim 9 was subsequently cancelled.

All remaining claims, numbered 1-8 and 10-22, are subject to final rejection and all are on appeal. No claims have been allowed or indicated as allowable if amended to overcome the rejection of a base claim.

Claims 1, 6, 10, and 13 are independent.

4. Status of Amendments

An amendment to remove possible lack of antecedent basis in the four independent claims, and thus place all claims in better condition for consideration in this appeal, is being filed on this date. No other amendments have been presented after the Final Rejection. Because the issues addressed by that amendments do not impact the Examiner's position as previously stated, the arguments advanced in this brief are applicable even if the amendments are not entered. For convenience, the Appendix contains the claims in both non-amended and amended form.

5. Summary of the Invention

Referring only to Figure 1 for simplicity, the invention comprises a file reading apparatus generally indicated at 10. The file reading apparatus 10 is useful for determining what files are on a data storage device 12. The file reading apparatus 10 includes a drive component 14 capable of reading the file directory information of the data storage device 12, and a display screen 16 for the user to view the file directory information. In operation, the user positions the data storage device 12 into a loading mechanism 22. Once the data storage device 12 is securely positioned by the loading mechanism 22 proximate the drive component 14, the file reading apparatus 10 automatically begins executing the read function.

The file reading apparatus 10, as defined by the claims on appeal, uses a programmed processor (not shown) to ensure that the apparatus may read and communicate only the file directory information to the display screen 16 or (in some embodiments) a printer (not shown in Figure 1). Such file directory information includes

the name and other parameters of the file, extensions applied to the file names depicting the type of software application needed to use a file, the amount of data space used or available on a data storage device 12, and the like This file directory information is in contrast to the file contents themselves. The apparatus is programmed to only display and print such file directory data; the programming of the apparatus does not include any capability of writing, modifying or otherwise manipulating the file contents.

6. Issues

Whether claims 1-8 and 10-22 are patentable under 35 USC § 103(a) over US 5,566,290 (“Silverbrook”) taken alone and not in view of any other reference.

Whether a claim limitation such as “operably connected to the drive component through the processor for viewing only the file directory information contained on the data storage device” is, in the context of a computer-based invention, a structural limitation under *In re Alappat*, or a statement of intended use under *Ex parte Masham*.

7. Grouping of Claims

For purposes of this appeal, claims 1-5 stand together, claims 6-8 stand together, claims 10-12 stand together, and 13-22 stand together; but these four groups of claims stand separately from each other.

8. Argument

- (i) Rejections under 35 USC § 112, first paragraph

Not applicable.

- (ii) Rejections under 35 USC § 112, second paragraph

Not applicable.

- (iii) Rejections under 35 USC § 102

Not applicable.

- (iv) Rejections under 35 USC § 103

Introduction

The sole pending Final Rejection for obviousness is against all pending claims over Silverbrook. The rejection is based on this single reference and not a combination of references.

The arguments below rely on the language of the claims prior to entry of the amendment mentioned above.

A Prima Facie Case of Obviousness Has Not Been Made

The Examiner has admitted that Silverbrook does not disclose any teaching of:

- “a visual display operably connected to the drive component through the processor for viewing only the file directory information contained on the data storage device” as recited by claim 1 (lines 13-15);
- “a printer operably connected to the drive component through the processor to print the file directory contents contained on the display” as recited by claim 6 (lines 12-13);

- “viewing only the file directory information contained on the data storage device, as read and communicated by the processor, through a display screen” as recited by claim 10 (lines 6-7); and
- “an output device connected to the processor for providing the file directory information contained on the data storage device” as recited by claim 13 (lines 8-9).

As the Examiner stated in the Final Rejection

The only limitation, which is not present in Silverbrook reference is that, the file information viewable on a visual display or printable by a printer is only the **file directory information**.

Paper No. 14, page 5; bold in original.

Therefore, the Examiner admits that the art of record does not include every claimed element, as required to support an obviousness rejection. This alone renders independent and dependent claims allowable. MPEP §2143.03.

The Examiner has not acknowledged these limitations, however. Instead, the Examiner has argued that “the aforementioned recitations recite only a way of intended use of the device ... it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987)” (underlining in original).

Please note, however, that each of the recited limitations positively links the apparatus or step of that limitation to the processor recited elsewhere in each claim, and thus to the drive component and other structural features of the invention. Taken together, these features define an apparatus that is structurally defined to accomplish a particular task, not one that may or may not perform that task at the whim of the user.

In re Alappat clearly establishes that a processor-based invention may be claimed in terms that use both hardware and software to recite structure. As stated in *Alappat*:

We have held that ... programming creates a new machine, because a general purpose computer in effect becomes a special purpose computer once it is programmed to perform particular functions pursuant to instructions from program software.

In re Alappat, 31 USPQ2d 1545, 1558 (Fed. Cir. 1994) (*en banc*) (omitting citations).

Therefore, the claimed limitations, when the claim is read as a whole as mandated by 35 USC § 103, recite structural distinctions and not merely intended use of the apparatus defined by the claims.

Specifically, claim 1 recites “a visual display operably connected through the drive component *through the processor* for viewing only the file directory information contained on the data storage device.” Earlier in the claim it is specifically stated that the “drive component [reads] the file direction information on the data storage device,” and the preamble to the claim explicitly puts life and meaning into the claim by using the same language: “a portable apparatus for reading only file directory information stored on a ... data storage device.” There can be no doubt that, when the claim as a whole is considered, that it contains structural limitations that limit the use of the claimed apparatus to displaying only file directory information.

Similarly, claim 6 recites “a printer operably connected to the drive component” instead of a visual display, but otherwise the previous paragraph applies.

Claim 10 defines a method in which the step of “viewing only the file directory information contained on the data storage device” is positively limited to the information

“read and communication by the processor” and in which the preamble again specifically gives meaning to the phrase “reading only file directory information.”

Finally, claim 13 uses the terms cited from claim 1 above, but in the context of an “output device” instead of the preferred embodiments of visual display (claims 1 and 6) or printer (claim 6); and without the non-controversial elements of the handheld housing (claims 1 and 6), and loading mechanism (claim 1). Claim 13 is also not limited to being “not in communication with a personal computer.”

In summary, the Examiner has indeed admitted that these structural requirements of the claim identify a distinction “between the claimed invention and the prior art [that] ... determine[s] whether the invention would have been obvious at the time the invention was made.” The Examiner’s error is that he has not followed the mandate that, absent an argument for obviousness based on such differences, “the claimed invention satisfies section 103.” *Examination Guidelines for Computer-Related Inventions*, 61 Fed. Reg. 7478, 7487 (1996); MPEP § 2106 (8th Edition, Rev. 1, Feb 2003).

Ex parte Masham is not inconsistent with this view. In that case, the applicant sought to claim a mechanical apparatus (a mixing apparatus) that did not have a structure capable of being changed in the manner of the claimed invention, with its programmed processor recited in the claims. Instead, the mixing apparatus of Masham had an *internal* construction that did not differ from the prior art apparatus, but the claim was sought to be distinguished based on the amount by which the apparatus was immersed in its external *environment* (developer fluid). The Board held that “the recitation ‘completely submerged in the developer material’ does not impose any structural limitations upon the claimed apparatus which differentiates it from that disclosed by” the prior art. But *In re Alappat* properly acknowledges that a programmed or processor is indeed changed in an internal manner by its programming, just as the claims on appeal require.

Given that *Alappat* is both more on point on the facts of the nature of the invention than *Masham*, and that it is an *en banc* decision handed down by this Board’s reviewing

court well after this Board's decision in *Masham*, it is clear that *Alappat* is the controlling authority in this appeal. The Examiner's reliance on *Masham* does not support his position and should not be persuasive.

Conclusion

For any of the reasons given above, and especially for all such reasons taken together, the pending rejection under 35 USC § 103 is improper and should be not be sustained.

(v) Rejections under other provisions

Not applicable.

9. Appendix

The Appendix contains a copy of the claims on appeal.

Very truly yours,

A handwritten signature in black ink, appearing to read 'Peter Forrest', with a stylized, flowing script.

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Appendix

CLAIMS ON APPEAL

Prior to Entry of Accompanying Amendment

- 1 1. A portable apparatus for reading only file directory information stored on a
2 separately portable self contained data storage device, the portable apparatus not
3 in communication with a personal computer, the apparatus comprising:
4 a handheld housing;
5 a drive component for reading the file directory information on the data
6 storage device;
7 a loading mechanism for receiving the data storage device and retaining
8 the data storage device such that the drive component reads the directory file
9 information on command;
10 a processor programmed to read and communicate only file information;
11 and
12 a visual display operably connected to the drive component through the
13 processor for viewing only the file directory information contained on the data
14 storage device.
- 1 2. The apparatus of claim 1 and further comprising a printer to print the file
2 directory information retrieved from the data storage device by the drive
3 component.
- 1 3. The apparatus of claim 1 wherein the visual display is a liquid crystal display.
- 1 4. The apparatus of claim 1 wherein the drive component reads magnetic storage
2 media.
- 1 5. The apparatus of claim 1 wherein the drive component reads optical storage
2 media.

- 1 6. A portable apparatus for reading only file directory content of a separately
2 portable data storage device, the portable apparatus not in communication with a
3 personal computer, the apparatus comprising:
4 a handheld housing;
5 a drive component disposed within the housing to read the data storage
6 device;
7 a processor programmed to read and communicate only file information;
8 a display disposed on the housing and connected to the drive component
9 through the processor for viewing the file directory contents; and
10 a printer operably connected to the drive component through the processor
11 to print the file directory contents contained on the display.
- 1 7. The portable apparatus of claim 6 wherein the printer is located within the
2 housing.
- 1 8. The portable apparatus of claim 6 wherein the printer is an attachable unit.
- 1 10. A method of reading only file directory information contained on a portable data
2 storage device, the method comprising:
3 inserting the data storage device into a loading mechanism of a portable
4 handheld file reader apparatus;
5 with a processor, reading and communicating only file information; and
6 viewing only the file directory information contained on the data storage
7 device, as read and communicated by the processor, through a display screen.
- 1 11. The method of claim 10 and further comprising:
2 printing the file directory information.
- 1 12. The method of claim 11 in which the printing is onto an adhesive label.

- 1 13. A portable apparatus for reading only file directory information from a separately
2 portable self contained data storage device, the portable apparatus comprising:
3 at least one data storage drive for reading the file directory information
4 from at least one respective type of data storage device;
5 a processor connected to the data storage drive programmed to read and
6 communicate only file information; and
7 an output device connected to the processor for providing the file directory
8 information contained on the data storage device.
- 1 14. The portable apparatus of claim 13, in which the output device is a visual display.
- 1 15. The portable apparatus of claim 13, in which the output device is a liquid crystal
2 display.
- 1 16. The portable apparatus of claim 13, in which the output device is a printer.
- 1 17. The portable apparatus of claim 16, in which the printer is located within the
2 apparatus.
- 1 18. The portable apparatus of claim 13, in combination with a portable printer which
2 is separate from and attachable to the portable apparatus.
- 1 19. The portable apparatus of claim 13, in which at least one drive component is a
2 magnetic storage drive.
- 1 20. The portable apparatus of claim 13, in which at least one drive component is an
2 optical storage drive.
- 1 21. The portable apparatus of claim 13, in which there are two drive components.
- 1 22. The portable apparatus of claim 21, in which one drive component is a magnetic
2 storage drive and another drive component is an optical storage drive.

CLAIMS ON APPEAL

After Entry of Accompanying Amendment

1. A portable apparatus for reading only file directory information stored on a separately portable self contained data storage device, the portable apparatus not in communication with a personal computer, the apparatus comprising:
 - a handheld housing;
 - a drive component for reading the file directory information on the data storage device;
 - a loading mechanism for receiving the data storage device and retaining the data storage device such that the drive component reads the file directory information on command;
 - a processor programmed to read and communicate only the file directory information; and
 - a visual display operably connected to the drive component through the processor for viewing only the file directory information contained on the data storage device.
- 1 2. The apparatus of claim 1 and further comprising a printer to print the file
2 directory information retrieved from the data storage device by the drive
3 component.
- 1 3. The apparatus of claim 1 wherein the visual display is a liquid crystal display.
- 1 4. The apparatus of claim 1 wherein the drive component reads magnetic storage
2 media.
- 1 5. The apparatus of claim 1 wherein the drive component reads optical storage
2 media.

- 1 6. A portable apparatus for reading only file directory contents of a separately
2 portable data storage device, the portable apparatus not in communication with a
3 personal computer, the apparatus comprising:
4 a handheld housing;
5 a drive component disposed within the housing to read the data storage
6 device;
7 a processor programmed to read and communicate only the file directory
8 content;
9 a display disposed on the housing and connected to the drive component
10 through the processor for viewing the file directory contents; and
11 a printer operably connected to the drive component through the processor
12 to print the file directory content contained on the display.
- 1 7. The portable apparatus of claim 6 wherein the printer is located within the
2 housing.
- 1 8. The portable apparatus of claim 6 wherein the printer is an attachable unit.
- 1 10. A method of reading only file directory information contained on a portable data
2 storage device, the method comprising:
3 inserting the data storage device into a loading mechanism of a portable
4 handheld file reader apparatus;
5 with a processor, reading and communicating only the file directory
6 information; and
7 viewing only the file directory information contained on the data storage
8 device, as read and communicated by the processor, through a display screen.
- 1 11. The method of claim 10 and further comprising:
2 printing the file directory information.
- 1 12. The method of claim 11 in which the printing is onto an adhesive label.

- 1 13. A portable apparatus for reading only file directory information from a separately
2 portable self contained data storage device, the portable apparatus comprising:
3 at least one data storage drive for reading the file directory information
4 from at least one respective type of data storage device;
5 a processor connected to the data storage drive programmed to read and
6 communicate only the file directory information; and
7 an output device connected to the processor for providing the file directory
8 information contained on the data storage device.
- 1 14. The portable apparatus of claim 13, in which the output device is a visual display.
- 1 15. The portable apparatus of claim 13, in which the output device is a liquid crystal
2 display.
- 1 16. The portable apparatus of claim 13, in which the output device is a printer.
- 1 17. The portable apparatus of claim 16, in which the printer is located within the
2 apparatus.
- 1 18. The portable apparatus of claim 13, in combination with a portable printer which
2 is separate from and attachable to the portable apparatus.
- 1 19. The portable apparatus of claim 13, in which at least one drive component is a
2 magnetic storage drive.
- 1 20. The portable apparatus of claim 13, in which at least one drive component is an
2 optical storage drive.
- 1 21. The portable apparatus of claim 13, in which there are two drive components.
- 1 22. The portable apparatus of claim 21, in which one drive component is a magnetic
2 storage drive and another drive component is an optical storage drive.